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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,330	01/22/2001	Scott Thomas Molloy	14013-29US	9338

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EXAMINER

SAM, PHIRIN

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/767,330	Applicant(s) MOLLOY, SCOTT THOMAS	
	Examiner Phirin Sam	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



**PHIRIN SAM
PRIMARY EXAMINER**

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1-16 are objected to because of the following informalities:

Regarding claim 1, line 1, “ARPA” should be rewritten as “advanced research projects agency (ARPA)”.

Regarding claim 2, line 1 “AWA” should be rewritten as example given above.

Regarding claims 3-16, these claims are similarly objected. Therefore, the appropriate corrections are required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 17-24 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,356,356 (hereinafter referred as “Miller”).

Regarding claims 17-20s, Miller discloses a method for sending and receiving e-mail messages using a fax device comprising:

- (a) receiving an e-mail message through a data communications network from an e-mail sender (see Figs. 1 and 2, col. 2, lines 65-66, and col. 4, lines 62-65);
- (b) converting the e-mail message into a fax document (see Fig. 4, col. 6, lines 63-67, and col. 7, lines 1-4);

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- (c) retrieving a fax number independent of the e-mail message (see Fig. 2, col. 4, lines 20-29);
- (d) transmitting the fax document to a fax recipient thereby enabling the fax recipient to receive e-mail messages without access to the data networking network (see Fig. 2, col. 4, lines 1-5, 16-20).

Regarding claim 21, Miller discloses a computer readable medium having stored therein computer readable program code comprising instructions for performing the following steps:

- (a) receiving an e-mail message, from through a data communications network (see Figs. 1 and 2, col. 2, lines 65-66, and col. 4, lines 62-65);
- (b) converting the e-mail message into a fax document (see Fig. 4, col. 6, lines 63-67, and col. 7, lines 1-4);
- (c) retrieving a fax number independent of the e-mail message (see Fig. 2, col. 4, lines 20-29);
- (d) transmitting the fax document to a fax recipient thereby enabling the fax recipient to receive e-mail messages without access to the data networking network (see Fig. 2, col. 4, lines 1-5, 16-20).

Regarding claims 22-24, Miller discloses a device comprising;

- (a) means for receiving an e-mail message, from through a data communications network (see Fig. 1 and 2, col. 2, lines 65-66, and col. 4, lines 62-65);
- (b) means for converting the e-mail message into a fax document (see Fig. 4, col. 6, lines 63-67, and col. 7, lines 1-4);

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(c) means for retrieving a fax number independent of the e-mail message (see Fig. 2, col. 4, lines 20-29);

(d) means for transmitting the fax document to a fax recipient thereby enabling the fax recipient to receive e-mail messages without access to the data networking network (see Fig. 2, col. 4, lines 1-5, 16-20).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,356,356 (hereinafter referred as "Miller") in view of US Patent 6,411,685 (hereinafter referred as "O'Neal").

Regarding claims 1-16, Miller discloses an advanced research projects agency (ARPA) Internet network access/service provider device comprising:
a fax gateway (see Fig. 1, col. 3, lines 26-29) including,

(a) the e-mail message to be converted to a fax document for transmission thereof to the fax recipient having access to a fax device (see Figs. 1, 2, and 4, col. 2, lines 65-66, and col. 4, lines 62-65, col. 6, lines 63-67, and col. 7, lines 1-4);

(b) at least one fax modem device for transmitting the fax document to the fax recipient through a public switching network (see Fig. 1, wherein it is obvious that there must be a fax

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modem resides in element 10 in order to send the fax), wherein a fax number designating the fax recipient is obtained independently of the e-mail (see Fig. 2, col. 4, lines 20-29);

Miller does not disclose a storage device for storing an e-mail message received from an e-mail sender for transmission to a fax recipient. However, O'Neal discloses the storage device for storing an e-mail message received from an e-mail sender for transmission to a fax recipient (see Fig. 1, col. 6, lines 13-24, 63-67, and col. 7, lines 1-18). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the storage device for storing an e-mail message received from an e-mail sender for transmission to a fax recipient teaching by O'Neal with Miller. The motivation for doing so would have been to provide to a broad range of communication options without necessitating significant user investment in hardware or software read on column 2, lines 47-49. Therefore, it would have been obvious to combine O'Neal and Miller to obtain the invention as specified in the claims 1-16.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 2, 5, 6, 10-15, 17, 19-22, and 24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) US Patent 6,633,630 (Owens et al) discloses system for integrated electronic communications.

(2) US Patent 6,424,426 (Henry) discloses fax-to-email and email-to-fax communication system and method.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phirin Sam whose telephone number is (571) 272-3082. The examiner can normally be reached on a compress schedule, from 8:00-5:30, first Wed off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571) 272 - 3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully submitted,

Date: May 15, 2006

A handwritten signature in black ink, appearing to read 'Phirin Sam', with a horizontal line underneath.

**PHIRIN SAM
PRIMARY EXAMINER**